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Datasheet for the decision of 17 December 2019

Case Number: T 0123/18 - 3.2.05

Application Number: 12185299.0

Publication Number: 2537676

IPC: B41F13/00, B41K3/12, B41K3/10, B41F33/00

Language of the proceedings: EN

Title of invention:
Numbering device for typographic numbering having independent driving means

Patent Proprietor:
KBA-NotaSys SA

Opponent:
Paul Leibinger GmbH & Co. KG Nummerier- und Markierungssysteme

Headword:

Relevant legal provisions:
EPC Art. 100(c), 111(1), 123(2)

Keyword:
Amendments - extension beyond the content of the application as filed (main request, auxiliary requests I, II, III, IIIa - yes) - extension beyond the content of the application as filed (auxiliary request IIIb - no)
Remittal to the department of first instance (yes)

Decisions cited:

Catchword:

Europäisches Patentamt
European Patent Office
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Beschwerdekammern

Boards of Appeal

Chambres de recours

Boards of Appeal of the
European Patent Office
Richard-Reitzner-Allee 8
85540 Haar
GERMANY
Tel. +49 (0)89 2399-0
Fax +49 (0)89 2399-4465

Case Number: T 0123/18 - 3.2.05

D E C I S I O N
of Technical Board of Appeal 3.2.05
of 17 December 2019

Appellant: (Patent Proprietor)	KBA-NotaSys SA PO Box 347 55, Avenue du Grey 1000 Lausanne 22 (CH)
Representative:	Thomas Hoffmann Koenig & Bauer AG - Lizenzen - Patente - Friedrich-Koenig-Straße 4 97080 Würzburg (DE)
Respondent: (Opponent)	Paul Leibinger GmbH & Co. KG Nummerier- und Markierungssysteme Daimlerstrasse 14 78532 Tuttlingen (DE)
Representative:	Hartwig Modrow Westphal, Mussgnug & Partner Patentanwälte mbB Am Riettor 5 78048 Villingen-Schwenningen (DE)
Decision under appeal:	**Decision of the Opposition Division of the European Patent Office posted on 3 November 2017 revoking European patent No. 2537676 pursuant to Article 101(3)(b) EPC.**

Composition of the Board:

Chairman	M. Poock
Members:	P. Lanz
	C. Brandt

Summary of Facts and Submissions

I. The patent proprietor lodged an appeal against the decision of the opposition division revoking European patent No. 2 537 676.

II. During the opposition proceedings, the opponent had raised the grounds for opposition according to Article 100(a) EPC in conjunction with Article 54 or Article 56 EPC (lack of novelty and lack of inventive step), as well as Articles 100(b) and 100(c).

III. Oral proceedings were held before the board of appeal on 17 December 2019.

IV. The appellant requested that the decision under appeal be set aside and the patent be maintained as granted (main request) or on the basis of auxiliary request I filed with the statement of grounds of appeal or on the basis of one of auxiliary requests II or III, both filed under cover of the letter dated 11 June 2018, or on the basis of one of auxiliary requests IIIa or IIIb, both filed during the oral proceedings on 17 December 2019.

V. The respondent (opponent) requested that the appeal be dismissed as main request and as auxiliary request that the case be remitted to the department of first instance for further prosecution with respect to the issues not addressed in the contested decision.

VI. Claim 1 according to the main request (i.e. the patent as granted) reads as follows:

"A numbering device (1) for carrying out numbering in sheet-fed or web-fed numbering presses, said numbering device (1) comprising a casing and a numbering unit (6) with rotatable numbering wheels (7) carrying alphanumerical symbols thereon, which numbering wheels (7) are disposed next to each other and rotate about a common rotation axis, said numbering device further comprising electro-mechanical actuation means for setting the position of said numbering wheels (7), wherein said electro-mechanical actuation means are disposed in an inner space of the casing of said numbering device (1) and are mechanically autonomous, said electro-mechanical actuation means comprising a plurality of independent driving means (15, 18-23; 23*) for actuating a corresponding plurality of said numbering wheels (7), wherein each independent driving means comprises an electric motor (15) driving the associated numbering wheel through a gear-wheel assembly (16, 19-23; 23*), which gear-wheel assembly (16, 19-23; 23*) exhibits a reduction factor (R_Z), wherein the electric motor (15) is a brush-less DC motor with electronic commutation, wherein each independent driving means exhibits an overall reduction factor (R) between an output of the electric motor (15) and the associated numbering wheel (7), wherein the numbering device comprises more than six rotatable numbering wheels (7) actuated by a corresponding number of independent driving means (15, 18-23; 23*), and wherein either all of the numbering wheels (7) are actuated by independent driving means (15, 18-23; 23*) or a part of the numbering wheels (7) are actuated by independent driving means (15, 18-23; 23*) and a

remaining part of the numbering wheels (7) are manually-actuated numbering wheels."

VII. Compared with the main request, claim 1 according to auxiliary request I comprises the following additional feature (underlined by the board):

"... wherein said electro-mechanical actuation means are disposed in an inner space of the casing of said numbering device (1) and are mechanically autonomous, wherein the casing comprises two side frame parts (3, 3') having bearings for the common shaft about which the numbering wheels rotate and the electro-mechanical actuation means being located between these side frame parts of the casing, ..."

VIII. Compared with the main request, claim 1 according to auxiliary request II comprises the following additional feature (underlined by the board):

"... wherein each independent driving means exhibits an overall reduction factor (R) between an output of the electric motor (15) and the associated numbering wheel (7), this overall reduction factor (R) between an output of the electric motor (15) and the corresponding numbering wheel (7) being selected to be such that a positional resolution of the numbering wheel, measured at its periphery, is of the order of 0.1 to 0.15 mm or less, ..."

IX. Compared with the main request, claim 1 according to auxiliary request III comprises both additional features of auxiliary requests I and II cited above under points VII. and VIII..

X. Compared with auxiliary request I, claim 1 according to auxiliary request IIIa comprises the following additional feature:

"the electric motor being coupled to the gear-wheel-assembly via a reduction gear,".

XI. Compared with auxiliary request III, claim 1 according to auxiliary request IIIb comprises the following additional feature:

"the electric motor being coupled to the gear-wheel-assembly via a reduction gear,".

XII. The arguments of the appellant can be summarised as follows:

Regarding the issue of added subject-matter in view of the divisional application as filed, it was observed that paragraphs [0019] and [0030] of the published application referred to a reduction factor. Paragraph [0046] of the published application defined an overall reduction factor R as follows (see equation (2)):

$$R = R_G * R_Z = R_G * (Z2 * Z4) / (Z1 * Z3)$$

wherein R_G was the reduction factor of the reduction gear and R_Z the reduction factor of the two-stage gearing. If no reduction gear was foreseen, R_G was equal to 1. Also in this case there was still an overall reduction factor. For these reasons, the overall reduction factor was not dependent on the presence or not of a reduction gear, the omission of which in claim 1 according the main request was therefore allowable.

Auxiliary requests I to III were to be admitted into the proceedings. It was noted that the opposition division, it its provisional assessment of the case, was of the view that the claims as granted did not go beyond the application as filed. In the contested decision the opposition division finally arrived at a different conclusion. The filing of auxiliary requests I to III was a legitimate reaction to this unexpected development. As to the substance, the reasoning set out above for the claim 1 of the main request equally applied to claim 1 of auxiliary requests I, II and III. These claim requests therefore met the requirements of Article 123(2) EPC.

Claim 1 of auxiliary requests IIIa and IIIb was further limited by adding the aspect of the electric motor being coupled to the gear-wheel assembly via a reduction gear. This was disclosed in paragraph [0030] of the published divisional application. For reasons of consistency with the other claim features, the term "gearing" in paragraph [0030] was amended to the synonymous wording "gear-wheel assembly". Since paragraph [0049] related to a specific example and not to the general disclosure of the overall reduction factor, it was not necessary to include the details of the positional resolution in claim 1 of auxiliary request IIIa.

Finally, auxiliary request IIIb included all the essential aspects of paragraph [0030] of the application as published. The further amendment to claim 1 was based on paragraphs [0037] and [0042] of the published application. The "bearings for the common shaft about which the numbering wheels rotate" clearly identified the location of the "side frame parts 3, 3'" at either ends of the "common shaft". These amendments

overcame the objection in the contested decision. The requirements of Article 123(2) EPC were therefore met.

XIII. The respondent's submissions may be summarised as follows:

The subject-matter of claim 1 according to the main request went beyond the content of the divisional application as filed, *inter alia* because of the wording that each independent driving means exhibits an overall reduction factor (R) between an output of the electric motor and the associated numbering wheel. In the published application (see paragraphs [0045] and [0046]) the overall reduction factor R was disclosed only in the context of coupling the electric motor to the two-stage gearing (16, 19-23) via a reduction gear (18). Paragraph [0049] of the published application also emphasised that a sufficiently fine adjustment of the position of the numbering wheel was achieved with an overall reduction factor of a reduction gear (18) and a two-stage gearing (16, 19-23). Finally, paragraph [0030] mentioned a reduction factor for a sufficiently fine adjustment of the position of the numbering wheel in the context of an electric motor being coupled to the gearing via a reduction gear. Hence, in the application as filed the overall reduction factor cited in claim 1 was disclosed only in combination with the aspect of the electric motor being coupled to the gear-wheel assembly via a reduction gear. However, in present claim 1 only the gear-wheel assembly exhibiting a reduction factor (R_z) was included but not the reduction gear. It was added that claim 10 as filed could not provide a basis for the contested amendment.

Auxiliary requests I to III should not be admitted into the proceedings since they were neither convergent nor

clearly allowable. Regarding the issue of added subject-matter, the reasoning set out above for claim 1 of the main request equally applied to claim 1 of auxiliary requests I, II and III. They did therefore not meet the requirements of Article 123(2) EPC.

The admission of auxiliary requests IIIa and IIIb was not contested. Claim 1 according to auxiliary request IIIa included the missing aspect of the electric motor being coupled to the gear-wheel assembly via a reduction gear. However, in paragraphs [0030] and [0049] of the published application the overall reduction factor was defined as being selected such that a positional resolution of the numbering wheel, measured at its periphery, is of the order of 0.1 to 0.15 mm or less. This general limitation was omitted from the claim 1 of auxiliary request IIIa, contrary to the requirements of Article 123(2) EPC. Moreover, the term "gear-wheel assembly" in the added feature was too broad.

Claim 1 of auxiliary request IIIb went beyond the application as filed because of the added features relating to the inner space of the casing. In particular, the term "side frame parts" was not clear, because it referred to a "frame" which has no antecedent in the claim and the relationship to the "casing" was not specified. Claim 1 comprised an intermediate generalisation, because "side frame parts 3, 3′" were originally only disclosed in combination with a "bottom from part 2": the further elements mentioned in the description were necessary to be able to understand how the "side frame parts 3, 3'" related to the casing. In addition, "cover member 4" and "side cover members 8" were also needed for completing the separation from the surrounding environment. No further

objections under the provisions of Article 123(2) EPC were raised against the claims of auxiliary request IIIb.

Since the contested decision only dealt with the requirements of Article 123(2) EPC, it was appropriate for board to remit the case to the opposition division for further prosecution.

Reasons for the Decision

1. Main request

1.1 The parties' dispute generally hinges on the question of whether the features relating to the independent driving means and the overall reduction factor (R), which were added to claim 1 during the examination proceedings, go beyond the disclosure of the divisional application as filed.

1.2 The contested features of claim 1 according to the main request have the following wording:

"wherein each independent driving means comprises an electric motor (15) driving the associated numbering wheel through a gear-wheel assembly (16, 19-23; 23), which gear-wheel assembly (16, 19-23; 23*) exhibits a reduction factor (R_z), [...] wherein each independent driving means exhibits an overall reduction factor (R) between an output of the electric motor (15) and the associated numbering wheel (7)".*

1.3 In the divisional application, the features of the gear-wheel assembly having a reduction factor (R_z) and the overall reduction factor (R) are specified in paragraphs [0045] and [0046] of the published

application (which correspond to page 14, lines 10 to 27 of the divisional application as filed):

[0045] It will be appreciated that each gear-wheel assembly 19-23 and associated toothed wheel 16 form a two-stage gearing as schematically illustrated in Figure 7. This two-stage gearing exhibits a determined reduction factor that depends on the ratios between the number of teeth of the pinions 20, 23, of the gear wheel 21 and of the toothed wheel 16. More precisely, the reduction factor R_Z of the two-stage gearing 16, 19-23 will be given by the following expression where Z1, Z2, Z3, Z4 are respectively the numbers of teeth of the first pinion 20, of the gear wheel 21, of the second pinion 23 and of the toothed wheel 16 :

$$R_Z = (Z2 * Z4) / (Z1 * Z3) \qquad (1)$$

[0046] As mentioned hereinabove, each motor 15 is preferably coupled to the two-stage gearing 16, 19-23 via a reduction gear 18. This reduction gear 18 provides an additional reduction of the output speed and an additional increase of the output torque of the motor 15. The reduction gear 18 also exhibits a reduction factor which will be referred to as R_G. The overall reduction factor R between the output of the motor 15 and the associated numbering wheel 7 will thus be given by the following expression :

$$R = R_G * R_Z = R_G * (Z2 * Z4) / (Z1 * Z3) \qquad (2)$$

These passages essentially define that the overall reduction factor R between an output of the electric motor and the associated numbering wheel is a product of reduction factor R_G of a reduction gear (18) and of reduction factor R_Z of a two-stage gearing including the gear-wheel assembly (19 to 23). There is no indication that the reduction gear is an optional element.

The beginning of paragraph [0049] of the published application (which corresponds to page 15, lines 24 to 28 of the divisional application as filed) relates to the same embodiment and contains the following additional information on the overall reduction factor:

"The overall reduction factor between the output of the electric motor 15 and the corresponding numbering wheel 7 is selected to be such that a positional resolution of the numbering wheel 7, measured at its periphery, is of the order of 0.10 - 0.15 mm or less, in order to

ensure a sufficiently fine adjustment of the position of the numbering wheels 7."

1.4 The disclosure in paragraphs [0045], [0046] and [0049] is consistent with the content of paragraph [0030] of the published divisional application (which corresponds to page 8, lines 9 to 16 of the divisional application as filed). This paragraph relates to an embodiment of the invention, according to which the electric motor is preferably coupled to the gearing via a reduction gear; However, in this paragraph it is further stated that a reduction factor between an output of the electric motor and the corresponding numbering wheels is selected to be such that a positional resolution of the numbering wheel, measured at its periphery, is of the order of 0.1 to 0.15 mm or less, which corresponds to the embodiment with the reduction gear of paragraph [0049] cited above.

Regarding the parties' reference to claim 10 of the divisional application as filed, it is added that claim 10 does not refer to the overall reduction factor. Already for this reason it cannot provide a direct and unambiguous basis for adding this aspect to independent claim 1.

1.5 The board concludes that, in the divisional application as filed, the overall reduction factor between an output of the electric motor and the associated numbering wheel is only disclosed in the context of a combination of a gear-wheel assembly and a reduction gear. There is no direct and unambiguous disclosure that the reduction gear is an optional element in this arrangement. Since claim 1 of the main request refers to the overall reduction factor and to the gear-wheel assembly, however without including the feature of the

reduction gear, its subject-matter constitutes an unallowable generalisation which goes beyond the content of the divisional application as filed (Article 100(c) EPC).

2. Auxiliary requests I, II and III

2.1 Admission of auxiliary request I

2.1.1 Auxiliary request I was filed together with the appellant's statement setting out the grounds of appeal.

2.1.2 The admission of auxiliary request I into the proceedings is governed by Article 12(4) RPBA. Under these provisions, the board has to take into account everything presented by the parties, *inter alia* in the notice of appeal, the statement of grounds of appeal and any written reply of the other party or parties, if and to the extent that it relates to the case under appeal and meets the requirements set out in Article 12(2) RPBA. The board, however, has the power to hold inadmissible facts, evidence or requests which could have been presented (or were not admitted) in the first-instance proceedings.

2.1.3 In this regard, the board notes that the opposition division, it its provisional assessment of the case in the annex to the summons for oral proceedings (see point I.2 on pages 5 to 7 of the annex), was of the view that the claims as granted do not go beyond the application as filed. It appears from the file that it was only in the light of the discussions during the oral proceedings that the opposition division changed its view and finally arrived at the opposite conclusion. Under these circumstances, it was not

apparent that auxiliary request I should have been presented in the first-instance proceedings. Rather, its filing at the outset of the appeal proceedings is considered an immediate and appropriate reaction to developments in the last phase of the opposition proceedings.

In view of this, the board exercises its discretion and admits auxiliary request I into the appeal proceedings under Article 12(4) RPBA.

2.2 Admission of auxiliary requests II and III

2.2.1 Auxiliary requests II and III were submitted with letter dated 11 June 2018, i.e. after the filing of the statement of grounds of appeal. Hence, their admission is to be decided on the basis of Article 13(1) RPBA. According to this provision, the board's discretion is to be exercised in view of, *inter alia*, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

2.2.2 Auxiliary request II and III are based on former auxiliary requests II and III filed together with the statement setting out the grounds of appeal. They were further amended in reaction to the reply to the appeal. Auxiliary requests II and III were submitted at an early stage of the proceedings and do not add any complexity to the appellant's case. Their submission is not detrimental to procedural economy, although auxiliary request II is not fully convergent with auxiliary request I.

Under these circumstances, the board exercises its discretion and admits auxiliary requests II and III into the appeal proceedings under Article 13(1) RPBA.

2.3 Added subject-matter

As explained above in point 1.5, in the application as filed the overall reduction factor between an output of the electric motor and the associated numbering wheel is only disclosed in the context of a combination of a gear-wheel assembly and a reduction gear. Claim 1 of auxiliary requests I, II and III refers to the overall reduction factor and to the gear-wheel assembly, however without including the feature of the reduction gear. Therefore, the reasons set out above for the main request for concluding that the subject-matter of claim 1 goes beyond the content of the divisional application as filed also apply to auxiliary requests I, II and III.

In view of this, the subject-matter of claim 1 of auxiliary requests I, II and III does not meet the requirements of Article 123(2) EPC.

3. Auxiliary requests IIIa and IIIb

3.1 Admission

3.1.1 Auxiliary requests IIIa and IIIb were filed during the oral proceedings before the board of appeal. They constitute an amendment to the appellant's case after oral proceedings have been arranged, the admission of which has to be judged on the basis of Article 13(1) and (3) RPBA.

3.1.2 In this respect it is observed that in its communication under Article 15(1) RPBA the board had provisionally concluded that the omission of the reduction gear in claim 1 according to the main request

did not seem to go beyond the divisional application as filed (see point 6.4.7 of the board's communication). After having discussed this issue with the parties during the oral proceedings, the board finally arrived at a different conclusion (see point 1.5 above). The subsequent submission of auxiliary request IIIa and IIIb including a reference to the reduction gear in claim 1 is considered a legitimate reaction by the appellant to the board's reconsideration of the question of added subject-matter. This is not contested by the respondent. Moreover, the amendments do not raise unexpected issues requiring the oral proceedings to be adjourned.

3.1.3 For these reasons, the board exercises its discretion and admits auxiliary requests IIIa and IIIb into the appeal proceedings under Article 13(1) RPBA.

3.2 Added subject-matter, auxiliary request IIIa

3.2.1 The appellant indicates paragraph [0030] of the published divisional application as a basis for adding the feature of the electric motor being coupled to the gear-wheel assembly via a reduction gear. The respondent essentially argues that in the original disclosure, in particular in paragraph [0030], the aspect of the overall reduction factor between an output of the electric motor and the corresponding numbering wheels was inextricably linked not only to the coupling of the electric motor to the gear-wheel assembly via a reduction gear but also to the requirement that the reduction factor was selected to be such that a positional resolution of the numbering wheel, measured at its periphery, was of the order of 0.1 to 0.15 mm or less. The latter is contested by the appellant.

3.2.2 In this regard, the board observes that paragraph [0030] of the published application states in clear terms that *"[a] reduction factor between an output of the electric motor and the corresponding numbering wheels is selected to be such that a positional resolution of the numbering wheel, measured at its periphery, is of the order of 0.1 to 0.15 mm or less."*

3.2.3 This unambiguous general teaching is also present in paragraph [0049] in the context of the detailed embodiment:

"The overall reduction factor between the output of the electric motor 15 and the corresponding numbering wheel 7 is selected to be such that a positional resolution of the numbering wheel 7, measured at its periphery, is of the order of 0.10 - 0.15 mm or less, in order to ensure a sufficiently fine adjustment of the position of the numbering wheels 7."

Applying this requirement to the specific embodiment, paragraph [0049] further explains that *"[f]or numbering wheels 7 having typical diameters of the order of 20 to 30 mm, this implies a resolution of several hundreds* [sic] *steps per turn (i.e. less than 1 ° angular resolution). For a given type of motor that is adapted to take, e.g. six different positions per revolution (such as Maxon's EC 6 motor), this yields an overall reduction factor in the range of one hundred, which reduction factor can easily be attained by means of the combination of the reduction gear 18 and the gearing 16, 19-23 mentioned hereinabove."*

3.2.4 Taking into account the divisional application as a whole, it is directly and unambiguously disclosed that,

in order to ensure a sufficiently fine adjustment of the position of the numbering wheels the overall reduction factor between the output of the electric motor and the corresponding numbering wheel has to be such that a positional resolution of the numbering wheel, measured at its periphery, is of the order of 0.10 - 0.15 mm or less. This is unambiguously presented as a general requirement which applies independently of the diameter of the numbering wheel or the type of motor. For these reasons, the board agrees with the respondent that in the divisional application as filed the feature of the overall reduction factor is inextricably linked to the positional resolution of the numbering wheel, measured at its periphery, being of the order of 0.10 - 0.15 mm or less.

Due to the omission of this requirement from claim 1, auxiliary request IIIa does not fulfil the provisions of Article 123(2) EPC.

3.3 Added subject-matter, auxiliary request IIIb

3.3.1 Claim 1 of auxiliary request IIIb contains the feature of the overall reduction factor in combination with aspects of the coupling of the electric motor to the gear-wheel assembly via a reduction gear and the positional resolution of the numbering wheel, measured at its periphery, being of the order of 0.10 - 0.15 mm or less. It therefore correctly reflects the disclosure in the application as originally filed, in particular in paragraph [0030] of the published divisional application, which corresponds to page 8, lines 9 to 16 of the divisional application as filed. For the sake of completeness, it is further added that in Figure 7 of the application as filed the electric motor (15) is

coupled to the gear-wheel assembly (19 to 23) via reduction gear (18).

3.3.2 Furthermore, the respondent objects to the definition of the casing in claim 1 according to auxiliary request IIIb. The features in question have the following wording:

"... wherein said electro-mechanical actuation means are disposed in an inner space of the casing of said numbering device (1) and are mechanically autonomous, wherein the casing comprises two side frame parts (3, 3') having bearings for the common shaft about which the numbering wheels rotate and the electro-mechanical actuation means being located between these side frame parts of the casing, ..."

The additional limitation is based on paragraph [0042] of the published application (which corresponds to page 12, line 31 to page 13, line 15 of the divisional application as filed):

"As already mentioned, one shall appreciate that the electro-mechanical actuation means of the numbering device are entirely located within the numbering device, i.e. are disposed in an inner space of the casing of the numbering device. As illustrated in Figure 3, the numbering wheels 7 are mounted for rotation about a common shaft 17 which is supported at both ends onto bearings provided in the side frame parts 3 and 3'."

The board notes that in all embodiments of the casing (see Figures 2, 4 and 11) the electro-mechanical actuation means of the numbering device are disposed in an inner space of the casing of the numbering device

between the side frame parts. Moreover, in the context of the application the numbering wheels are always mounted for rotation about a common shaft which is supported at both ends onto bearings provided in the side frame parts. Hence, the disclosure of paragraph [0042] of the published application provides a direct and unambiguous basis for this aspect of claim 1 of auxiliary request IIIb. It is further noted that the claim clearly identifies the relation of the side frame parts and the casing. Under these circumstances and in view of the unambiguous disclosure in paragraph [0042] of the published application, the omission of the further elements of the casing does not render the contested claim amendment unallowable.

3.3.3 The respondent did not present any further objections under Article 123(2) EPC against the claims of auxiliary request IIIb.

3.3.4 For these reasons, the board concludes that the claims of auxiliary request IIIb meet the requirements of Article 123(2) EPC.

4. Remittal of the case

4.1 Under Article 111(1) EPC, the board of appeal may either decide on the appeal or remit the case to the department which was responsible for the decision appealed. The appropriateness of remittal to the department of first instance is in the discretion of the board, which assesses each case on its merits. Even if there is no absolute right to have every issue decided upon by two instances, it has to be emphasised that it is the primary function of an appeal to give the losing party the possibility of having the correctness of the first-instance decision judicially

reviewed. Further criteria which can also be taken into account when deciding on a remittal include the parties' requests, the general interest that proceedings are brought to a close within an appropriate period of time and whether or not there has been a comprehensive assessment of the undecided issues during the appeal proceedings.

4.2 In view of the fact that during the oral proceedings before the opposition division only the issue of added subject-matter in view of the divisional application as filed was discussed and since the further grounds for opposition were neither examined by the opposition division nor comprehensively dealt with by the parties during the appeal proceedings, the board exercises its discretion under Article 111(1) EPC and decides to follow the respondent's request for remitting the case to the department of first instance for further prosecution.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.

2. The case is remitted to the opposition division for further prosecution.

The Registrar: The Chairman:

N. Schneider M. Poock

Decision electronically authenticated